

Serial No. 09/754,465  
Attorney No. 10655.9900  
AXP No. 200301935

### **REMARKS**

Applicants reply to the Office Action dated December 5, 2005 within the shortened three month statutory period for reply. Claims 1, 3-5, 39 and 40 were pending in the application and the Examiner rejects claims 1, 3-5, 39 and 40. No new matter is added in this Reply. Applicants assert that the application is in condition for allowance and reconsideration of the pending claims is requested.

### **Rejections Under 35 U.S.C. § 112**

The Examiner rejects claims 1, 3-5, 39 and 40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that, "[t]he claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (page 3, item 4). Applicants respectfully traverse this rejection.

In regard to claims 1, 39, and 40, the Examiner asserts that the specification "recites using a smart card for debit and credit transactions and does not disclose a card reader or inserting a card into a reader" (page 4, paragraph 2). As the Examiner has noted, the specification discloses that, "[u]ser 110 is then directed by wallet server 140 to insert a Smart Card into the system to verify that a Smart Card is in the user's 110 possession" (page 10, lines 22-25). Those skilled in the art would immediately appreciate that the "system" that the card is being inserted into or read by for verification purposes, is a card reader. However, to expedite prosecution, Applicants have amended the claims to recite a "card reader system" which is adequately disclosed at, for example, Column 11, lines 38-40 in U.S. Patent No. 6,581,839 (Application Serial No. 09/653,837), filed on September 1, 2000, which is incorporated by reference within the originally filed disclosure.

The Examiner also asserts that the specification lacks support for "signature data" and the processing thereof. Applicants have amended the claims to clarify that the "signature data" is, for example, a digital certificate. A digital certificate and its processing thereof are disclosed starting at page 10, line 25 of the specification.

Serial No. 09/754,465  
Attorney No. 10655.9900  
AXP No. 200301935

Accordingly, Applicants submit that claims 1 (and claims 3-5 depending therefrom), 39, and 40 fully conform with 35 U.S.C. § 112.

**Rejections Under 35 U.S.C. § 103**

The Examiner rejects claims 1, 3-5, 39 and 40 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,327,578 issued to Linehan ("Linehan"). Applicants respectfully traverse these rejections. In light of the forgoing amendments, Applicants respectfully request the Examiner to consider the following arguments which were not given weight due to the Examiner's 35 U.S.C. § 112 rejections.

In making the rejection, the Examiner characterizes Linehan as essentially showing each of the elements of claims 1 and 40 in the instance when, by coincidence, a merchant and a user share the same bank or financial institution. The networks disclosed in Linehan send "from a consumer's computer a start message over an internet to a merchant's computer." Linehan, Column 4, lines 10-12. "The merchant's computer then replies to the consumer's computer with a merchant message including a wallet initiation message, a merchant digital signature, and a digital certificate from an acquiring bank." Id., lines 12-16. The consumer's wallet program is then started in the consumer's computer in response to the wallet initiation message. "The consumer's computer then sends over the internet network some consumer identity and authentication information, such as a userid and user password, plus the merchant message, to an issuer gateway operating on behalf of an issuing bank." Linehan, Column 4, lines 19-23. Thus, in Linehan, a user inputs his/her user ID and user password for identification for authentication purposes. Linehan does not disclose or suggest reading data directly from, or a card reader system physically interfacing with, a debit card, a credit card, a charge card, or a smart card to verify that the consumer is in actual possession of the debit card, credit card, charge card, or smart card. As such, Linehan does not disclose or suggest at least "receiving a digital certificate, read by said card reader system, from at least one of said debit card, said credit card, said charge card, and said smart card, wherein at least one of said debit card, said credit card, said charge card, and said smart card each includes said digital certificate configured to authenticate that at least one of said debit card, said credit card, said charge card, and said smart card was physically interfaced

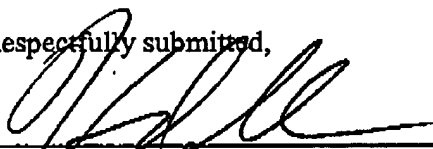
Serial No. 09/754,465  
Attorney No. 10655.9900  
AXP No. 200301935

with said card reader system" (emphasis added), as similarly recited by independent claims 1, 39 and 40.

Claims 3-5 depend from independent claim 1 and include all of the elements thereof. Therefore, Applicants submit that claims 3-5 are differentiated from the cited reference for at least the same reasons as set forth above, as well as in view of their own respective features.

In view of the above remarks and amendments, Applicants respectfully submit that all pending claims properly set forth that which Applicants regard as their invention and are allowable over the cited references. Accordingly, Applicants respectfully request allowance of the pending claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience, if that would help further prosecution of the subject application. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814, including any required extension fees.

Respectfully submitted,



Howard Sobelman  
Reg. No. 39,038

Dated: March 6, 2006

**SNELL & WILMER L.L.P.**  
400 E. Van Buren  
One Arizona Center  
Phoenix, Arizona 85004  
Phone: 602-382-6228  
Fax: 602-382-6070  
Email: [hsobelman@swlaw.com](mailto:hsobelman@swlaw.com)